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In the
Supreme Court of the United States

OCTOBER TERM, 1962

No. [redacted] 138

HELEN RUSSELL PIERCE, Executrix of the Last Will and Testament of GEORGE WASHINGTON PIERCE, Deceased,
PETITIONER,

v.

ALLEN B. DUMONT LABORATORIES, INC.,
RESPONDENT.

PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE THIRD CIRCUIT

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To the Honorable Chief Justice and Associate Justices of the Supreme Court of the United States:

Your petitioner, Helen Russell Pierce, executrix of the estate of the late Professor George Washington Pierce, respectfully prays that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the Third Circuit, entered in the above-entitled action on November 29, 1961.

A certified transcript of the record in the above case

(hereinafter referred to as "Tr."), including the proceedings in the said Court of Appeals, is furnished herewith.

Opinions Below

The opinion of the Court of Appeals for the Third Circuit is reported at 297 F.2d 323 (1961) and appears as Appendix A to this petition, and at Tr. 115b.

A conflicting opinion of the Court of Appeals for the Fifth Circuit, *Pierce* v. *Aeronautical Communications Equipment, Inc.*, (C.A. 5, 1958) is reported at 255 F.2d 458 and appears as Appendix B to this petition.

Jurisdiction

The judgment of the Court of Appeals for the Third Circuit was entered on November 29, 1961. An order extending the time for filing this petition for certiorari to and including May 25, 1962, was issued by this Honorable Court on March 9, 1962 (Associate Justice William J. Brennan, Jr.). The jurisdiction of this Court is invoked under 28 U.S.C. Sec. 1254(1).

Specifically, this petition involves a case where the Court of Appeals for the Third Circuit has rendered a decision in conflict with a decision of the Court of Appeals for the Fifth Circuit with regard to the *same* patent,[1]—a decision that constitutes *brand new law* as to which no authority is even cited, and which is diametrically opposite to all prior decisions of the Supreme Court.

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[1] Rule 19(b) of this Court re jurisdiction in conflicting decisions of courts of appeals on same matter. See, also, *Electric Cable Co.* v. *Edison Co.*, 292 U.S. 69, 70; and *Sola Electric Company* v. *Jefferson Electric Company*, 317 U.S. 173, 174-175.

Question Presented

I.

Whether the Court of Appeals for the Third Circuit is correct in holding, as a new proposition of law, that it constitutes an illegal "extension" of patent "monopoly" for an inventor to issue his application for a novel element [2] as a patent, *after* the issuance of his copending application for a combination [3] using such novel elements?

(This Court may wish to postpone action on this petition pending the outcome of a further decision on this same issue by the Court of Appeals for the Fifth Circuit; the argument in which cause has been set for hearing June 26, 1962.)

Statute Involved

The pertinent statute is the New Patent Act of 1952, enacted pursuant to the Constitutional provision, Article I, Section 8, relating to the grant of patents for invention.

Statement of the Case

Introduction

The late Professor George Washington Pierce, of Harvard University, is recognized throughout the world as the inventor of the said Pierce oscillator—an electronic circuit operating under the control of a quartz piezo-electric

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[2] The so-called Pierce oscillator—an electronic oscillation circuit that produces electrical oscillations of constant frequency, in world-wide use not only in radio, but in scientific instruments, in sound generators, calibrators, and many other applications. (Patent 2,113,642)

[3] A cooperative radio transmitter-and-receiver combination having a first Pierce oscillator at the transmitter cooperating with a second Pierce oscillator at the receiver (Claim 2—Patent 1,789,496)

crystal for producing electrical oscillations of very constant frequency.

The three Courts of Appeals for the First, Third and Fifth Circuits are agreed that this Pierce oscillator constituted a patentable invention.

The Pierce oscillator is employed, as an oscillating element, in many different combinations of electrical equipment. It is not restricted to use in radio [2].

Each of the Courts of Appeals of the First, Third and Fifth Circuits, agrees that patent 2,133,642, here in issue, covers the Pierce oscillator circuit *per se* and thus, for purposes of discussion, may be referred to as the basic novel *element* patent.

Each of the said Courts of Appeals agrees that earlier-issued Pierce patent 1,789,496 involves only *combination* claims for a combined cooperative radio transmitter-and-receiver system; and that in only *one* claim thereof (claim 2), and not in either of the other two claims, was the Pierce oscillator even specified as an element of the combination. And at that, this one claim called for *two*, cooperative Pierce oscillators—one at the transmitter and one at the receiver—and *not* for a single Pierce oscillator alone.

Each of the said Courts of Appeals further agrees that at one time Dr. Pierce tried to issue his Pierce oscillator element claims in the same patent as the cooperative transmitter-and-receiver combination claims, but that the Patent Office refused to permit this to be done.

Each of the said Courts of Appeals additionally agrees that the patent examiner requested Dr. Pierce's attorney to file a separate divisional application for the cooperative transmitter-and-receiver combination.

The Courts of Appeals for the First and Fifth Circuits have held this to be a *formal* requirement for division; but the Court of Appeals for the Third Circuit, following the

decision of the District Court for the District of Delaware, has held this to be an *informal* requirement for division expressed at an interview with the examiner, and made of record in a contemporaneous paper filed by the attorney.[4]

Each of the said Courts of Appeals, however, agrees that the divisional application for the transmitter-and-receiver *combination* issued as a patent, *first;* and that the basic Pierce oscillator patent for the Pierce oscillator *element* alone, was involved in interferences and issued later.

This *combination* patent, involving in one claim thereof, the cooperative use of two Pierce oscillator elements, thus issued before the Pierce oscillator *element* patent, and Question 1, *supra*, is thus raised; namely, in trying to enforce the basic Pierce oscillator element patent, is Dr. Pierce now unlawfully extending any patent "monopoly"?

The District Court for the District of Massachusetts, in the initial case involving this patent held,[5] 111 F. Supp. 181, 189

> "Pierce's two patents are *not* for the same invention . . . Once he has succeeded in geting patent protection for his basic invention *he should be entitled to enjoy that protection for the full period allowed by the law.* (citations)" (emphasis supplied).

The Court of Appeals for the First Circuit reversed, however, holding, 208 F.2d 763, 769

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[4] Paper No. 10, October 22, 1927 (PX37 and DX3, page 61, 62): "The applicant is preparing divisional applications . . . in accordance with the requirements of the Office, both formally expressed in the Office letters and informally expressed during the said interview."

[5] At these earlier and incomplete stages of this litigation, this Court declined certiorari, *Pierce* v. *American Communications Co., Inc.*, (C.A. 1, 1953) 208 F. 2d 763, cert. denied 347 U.S. 970, 348 U.S. 851; (C.A. 1, 1960) 280 F. 2d 278, cert. denied 364 U.S. 902; *Pierce* v. *Hewlett Packard Co.*, (C.A. 1, 1955) 220 F. 2d 531, cert. denied 350 U.S. 833.